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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,428	09/27/2001	John E. Jones	47171-00298	3631
30223 7590 02/08/2006				
JENKENS & GILCHRIST, P.C. 225 WEST WASHINGTON SUITE 2600 CHICAGO, IL 60606				
EXAMINER BHATNAGAR, ANAND P				
ART UNIT PAPER NUMBER 2623				

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/965,428

Applicant(s)

JONES ET AL.

Examiner

Anand Bhatnagar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 165-167, 170-172, 174, 21 1-212, 215-225, 257-258, 261-264, 278, 281, 284,

287, 290, 293, 296, 299, 302 and 305 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims pending in the application are 1-212,215-225,257,258,261-264,278,281,284,287,290,293,296,299,302 and 305.

DETAILED ACTION

1. Applicants response, filed 10/17/05, to examiner's non-compliant action has been entered and made of record. The claims and figures (claim #'s 165-167, 170-172, 174, 211-212, 215-225, 257-258, 261-264, 278, 281, 284, 287, 290, 293, 296, 299, 302 and 305 and figures 3a-3d, 5, and 15) that have been elected by the applicant still are restrictable and a new one is given below.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 165-174 and 219-225, are drawn to detecting counterfeit documents, classified in class 382, subclass 100.
 - II. Claims 165-174, 211, 212, 219-225, 257, 258, 278, 281, 284, and 287 are drawn to detecting counterfeit currency bills, classified in class 382, subclass 135.
 - III. Claims 165-174, 215, 216, 219-225, 261, 262, 290, 293, 296, and 299, drawn to detecting counterfeit checks, classified in class 382, subclass 137.

Inventions I and II are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in

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other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because to detect a watermarked document (such as, image, printed document, etc.) does not need the process of extracting a serial number from the currency to detect if it is counterfeit. The subcombination has separate utility such as detecting fraudulent currency.


Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because to detect a watermarked document (such as, image, printed document, etc.) does not need the process of extracting an ABA number from the check to detect if it is counterfeit. The subcombination has separate utility such as detecting counterfeit checks.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Further, within the subcombinations cited by the examiner there still exists species within these groups. If applicant elects either of the subcombinations then applicant needs to elect a single species from these subcombinations.

Contact Information

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anand Bhatnagar whose telephone number is (571) 272-7416, whose supervisor is Jingge Wu whose number is (571) 272-7429, Central fax is 571-273-8300, and Tech center 2600 customer service office number is 703-306-0377.


SAMI AHMED
PRIMARY EXAMINER



Anand Bhatnagar

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February 6, 2006